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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Date: December 2, 2004

Serial No.: 10/007,483

Group Art Unit: 1636

Filed: 12/05/2001

Examiner: Nancy S. Vogel

Title: DOUBLE TRANSPOSITION METHODS FOR MANIPULATING NUCLEIC ACIDS

Docket No.: 960296.97541

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In an Office Action mailed September 22, 2004, the Examiner in charge of the above-noted application imposed a requirement for restriction.

In response, applicants provisionally elect restriction Group I (Claims 1-8, drawn to a polynucleotide comprising first and second transposase-interacting inverted repeat sequence pairs, classified in class 536, subclasses 23.1 and 24.1) with traverse and without prejudice to the eventual filing of a divisional application on any restriction Groups I-VII.

The restriction is traversed on the grounds that a complete search of the subject matter of the method of Groups II-V; the polynucleotide fusion product of Group VI; and the self replicating nucleic acid molecule of Group VII should bring to light the art relevant to the claims of Group I. The claims of Group II-VII recite and utilize either directly or indirectly a polynucleotide having a pair of non-identical interacting sequences. The polynucleotide recited in Group I is specifically utilized in the methods of Groups II-V; the fusion product of Group VI; and the self replicating nucleic acid molecule of Group VII. Accordingly, the constructs and methods of the invention all employ two pairs of inverted repeat sequences

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(“transposase-interacting sequences”) that bind to and interact with a pair of transposase enzymes to facilitate direct double transposition as detailed in the application. Also, the polynucleotide of Group I is not designed for general use, but rather for the particular purpose of directing sequential transposition processes to achieve the desired manipulated nucleic acids. Therefore, applicants believe that the claims in groups I-VII are closely linked.

Applicants believe that a proper search for one group of claims would inevitably overlap with that for the others and the search results for one is relevant to the others. For example, a proper search for all these groups would involve searching for a polynucleotide having a pair of non-identical interacting sequences. If the result of such a search is found patentable, all of the groups would also be considered patentable. In this regard, the applicants further note that all seven groups are classified under overlapping class and subclasses.

Also, applicants note that restriction requirements are optional in all cases. MPEP § 803. If the search and examination of a set of claims can be made without serious burden, the Examiner must examine them on the merits, even though they may be arguably directed at distinct or independent inventions. MPEP § 803. In the present application, and as described hereinabove, it is respectfully submitted that claims in groups I-VII can be examined together without serious burden on the Office. On the contrary, it will be unnecessarily burdensome on both the applicants and the Office to consider the highly related subject matter in separate patent applications.

For these reasons, applicants respectfully request that the restriction requirement on groups I-VII be reconsidered and withdrawn.

A petition for a two month extension of time accompanies this response so that the response will be deemed to have been timely filed. Should any other extension of time be due, please consider this to be a request for the appropriate extension of time and a request to charge the fee due to the Deposit Account No. 17-0055. Likewise, no other fee is believed due, but should any other fee be due, in this or any subsequent application, please consider this to be a request to charge the fee to the same deposit account.

Respectfully submitted,


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